REMARKS

Applicants thank the Examiner for the teleconference on January 5, 2004, discussing the rejections under 35 U.S.C. §101.

In the October 6, 2003, Office Action, the Examiner rejected claims 24 and 25 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, and rejected claims 1-23 and 24-57 under 35 U.S.C. § 101 as directed to non-statutory subject matter. In addition, the Examiner rejected claims 1-15, 18-21, 23, 26-35, 38-49, 52-55, and 57 under 35 U.S.C. § 103(a) as unpatentable over "VIT's 'SeeChain NOW!' Program Delivers Supply Chain Visibility for SAP Customers in as Little as 90 Days," PR Newswire, Sept. 13, 1999 ("*PR Newswire*") in view of "DeskTalk Announces Next Generation TREND ReportPacks Automating Web-Based Performance Reporting," Business Editors, Business Wire May 5, 1998 ("*Business Editors*"); and rejected claims 16, 17, 22, 24, 25, 36, 37, 50, 51, and 56 under 35 U.S.C. § 103(a) as unpatentable over *PR Newswire* and *Business Editors* further in view of U.S. Patent No. 5,630,069 to Flores et al. The Examiner also objected to claim 23 as missing a period at the end. Applicants have amended claim 23 to correct this informality.

Claims 1-57 are pending.

35 U.S.C. § 112, First Paragraph

In the Office Action, the Examiner rejected claims 24 and 25 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Specifically, the Examiner alleged that the process of "identifying" is not described in any detail to allow one skilled in the art to perform the task.

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Applicants have amended Claim 24 to explain that the method for creating a collaboration between participants in a business scenario comprises the steps of accepting information identifying several elements; and creating, in a data processing system, a collaboration for sharing a portion of the information accepted.

Adding to the claim that the method, rather than requiring the identification, requires accepting information about the identification, obviates the bases for the rejection. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. A patent need not teach, and preferably omits, what is well known in the art. (See MPEP § 2164.01 (citations omitted)).

Here, the specification discloses the information used by one of ordinary skill to identify the features recited in claim 24. For example, regarding the embodiment shown in FIG. 2, the specification states:

> Information for the CBS may be obtained from various sources, such as industry, business, or value chain expertise, knowledge on value-added activities of each of the participants involved, knowledge on the individual information needs of each role in the entire business scenario, knowledge of employee roles, data modeling expertise, knowledge of the industry business blueprints and Solution Maps (described below), business application expertise (e.g., SAP Financials), implementation expertise, identification of value potentials by realizing collaborative business opportunities that result in tangible business benefits, industry knowledge anticipating the quantifiable business benefits, and/or independent studies (e.g., Harvard Business Review, Goldman Sachs, Management Consulting Firms).

(Specification, page 7).

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The specification also notes that identifying the participants leads to identifying the type of collaborative business scenario that applies:

> The types of participants identified (e.g., OEM, importers, dealers) will dictate the type of CBS to use. For example, if the participants are employees of different enterprises (e.g., OEM, importer, dealer), the type of CBS is a "Business to Business Scenario" CBS. As another example, if the participants are buyers and sellers in an electronic marketplace, then the type of CBS is a "mySAP.com Marketplace Scenario." In yet another example, if the parties are multiple enterprises working together to supply information to a set of customers, then the CBS is a "Customer Interaction Scenario."

(Specification, pages 6-7).

35 U.S.C. § 101

The Examiner also rejected claims 1-57 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Regarding independent claims 1 and 24, in the interview, the Examiner indicated that he gave no weight to the preamble recitation of execution by a data processing system and thus alleged that these claims recite only an abstract idea not within the technological arts. Applicants disagree because there is no legal precedent for such a position. Nevertheless, to advance prosecution, Applicants have amended claims 1 and 24 to recite that the actions in the methods are executed by a data processing system, which moots the rejection of these claims under 35 U.S.C. § 101, as well as the rejection of claims 2-5 and 25, which depend from claims 1 and 24, respectively.

The rejection of the other claims appears to be based on a misunderstanding that the claims merely recite the storage of views which have no relationship to a computer. Of course the claims do more than merely store pictures. Claim 6, for example, recites "rendering, using a data processing system, a first graphical depiction of a sequence of interactions between different ones of the participants, the depiction including polygons

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being juxtaposed to indicate the sequence and participants of each of the interactions; and rendering, using the data processing system, a second graphical depiction, derived from the first graphical depiction, of an information flow." The claim thus covers producing a display of information in a specific format using a data processing system. Even the Federal Circuit has held that producing a display of data in a specific format meets the requirements of 35 U.S.C. § 101. *In re Alappat*, 33 F. 3d 1526, 31 USPQ 2d 1545 (Fed. Cir. 1994).

In Section 2106 IV B. 2 (b) (iii), the MPEP merely requires that for a computer-related process to be statutory, "the claimed process must be limited to a practical application" of some abstract idea or mathematical equation. This reiterates the test the Federal Circuit set forth in several cases, such as *AT&T Corp. Excel Communications, Inc.*, *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), and *In re Alappat*. The practical application of this invention includes a useful presentation of information. The rejection under § 101 is therefore not well taken.

35 U.S.C. § 103(a)

The Examiner's rejection of claims 1-15, 18-21, 23, 26-35, 38-49, 52-55, and 57 under 35 U.S.C. § 103(a) over the *PR Newswire* article in view of the *Business Editors* article does not constitute a *prima facie* rejection. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner must demonstrate that (1) the references disclose or suggest each and every element recited in the claims; (2) there is a reasonable probability of success of any modification of the teachings of the references, and (3) there exists some suggestion or motivation, either in the teachings

of the references themselves or in the knowledge generally available to one of ordinary skill in the art, to make such a modification in a manner resulting in the claimed invention. M.P.E.P. § 2143.

The Examiner contends that *PR Newswire* discloses an "e-supply chain performance measurement application using reports and graphs," and "a timeline."[1] Even if this were true, the *PR Newswire* does not disclose or suggest what is actually recited in claim 1, namely "providing on a display device . . . a business view depicting a plurality of interlocked polygons illustrating interactions between the participants, the polygons being positioned relative to each other to define the participants for the interactions" or "deriving an interaction view from the business view . . ., the interaction view depicting additional information between the participants." Nothing in the *PR Newswire* (1) depicts polygons; (2) illustrates interactions between participants; (3) shows a positioning that defines participants; or (4) derives any type of interaction view.

The Examiner also indicates that "[t]he actual shape and alignment of the picture or graph features are non functional [and] therefore are not given any patentable weight," but this is a misapplication of the relevant law. What the Examiner is reviving is the old "printed matter" rejection, which holds that "Where the printed matter is not functionally related to the substrate the printed matter will not distinguish the invention

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[1] *PR Newswire* is a short press release about a supply chain performance measurement program that allows manufacturers to see and collaborate across the global supply chain of a single enterprise. (*PR Newswire*, para. 1). The program includes "XML-driven reports" that "allow users to enter parameters, such as timeline and product type, to automatically generate up-to-date reports and graphs in Microsoft® Excel." (*PR Newswire*, para. 3).

from the prior art in terms of patentability." *In re Gulack*, 703 F.2d 1381, 1385, 217

USPQ 401, 404 (Fed. Cir. 1983).

Gulack, however, cautioned against extending the printed matter rejection to

computer cases.

> A "printed matter rejection" under § 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. . . . [The Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated.

703 F.2d at 1385 n.8.

When the USPTO tried to do this in another context, the CCPA explained,

> On their facts, those cases dealt with claims defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind. Here the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer, and that the drawing be done not by a draftsman but by a plotting machine. Those "printed matter" cases therefore have no factual relevance here.

In re Bernhart, 417 F.2d 1395, 1399 163 USPQ 611, 615 (CCPA 1969). *See also In re*

Lowry, 32 F.3d 1579, 1583 (Fed. Cir. 1994).

In claim 1, for example, the interlocked polygons illustrate interactions between

the participants and define the participants for the interactions." These define functions

determined by a data processor and are worthy of patentable weight. They are not

mere drawings printed on paper. *PR Newswire* does not disclose or suggest the

interlocked polygons and their positioning relative to each other, as recited in claim 1.

All the *PR Newswire* article teaches is entering search parameters about a

supply chain, "such as timeline and product type," in a database query to generate

reports and graphs in Excel. There is no timeline displayed, it is a search parameter.

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Moreover, even if *PR Newswire* disclosed a displayed timeline (which it does not), a timeline is nonetheless just a straight line with times and descriptions on it. A timeline does not have specifically positioned interlocking polygons and does not illustrate interactions between participants. *PR Newswire*'s passing mention of conventional reports, graphs, and timelines for monitoring a supply chain does not teach or suggest a business view depicting a plurality of interlocked polygons illustrating interactions between the participants, the polygons being positioned relative to each other to define the participants for the interactions, as recited in claim 1.

Moreover, neither *Business Editors* nor *Flores* discloses or suggests any of the foregoing recited features. For at least the foregoing reasons, neither *PR Newswire* nor *Business Editors*, nor *Flores*, whether taken alone or in combination, teach or suggest all the features recited in independent claim 1. Accordingly, a prima facie case of obviousness has not be established, and claim 1 is allowable over these references. Since independent claims 6, 21, 26, 40, and 55 recite similar features, all of which are absent from the cited references, they are also allowable as are dependent claims 2-5, 7-20, 22-23, 27-39, 41-53, and 56-57.

Claim 24, which is slightly different, recites a method for creating a collaboration between participants in a business scenario comprising accepting information into a data processing system, identifying specific elements, and creating a collaboration for sharing a portion of the accepted information. Nothing in any of the cited references discloses or suggests either accepting the specified information or creating a collaboration. Therefore, independent claim 24 and dependent claim 25 are allowable over the cited references as well.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request withdrawal of the rejections, reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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